

### Remarks

Claim 16 has been changed to dependent form. Support for new claim 19 can be found, for example, in claim 18. Support for new claim 20 can be found, for example, in claim 16. Support for new claim 21, can be found for example, in claim 1. No new matter has been added.

### Restriction Requirement

It is self-evident that the claims of the Group II and III are not process claims. Despite this fact, the Examiner appears to argue that the claims of Group I and the device and composition claims of Groups II and III can be "related" as product and process of use (see April 2003 Office Action). The Examiner argues the Restriction in this case is justified under MPEP §806.05(h) (see April 2003 Office Action). However, nothing within this section of the MPEP indicates that such a Restriction is appropriate in situations where there are no process claims. This section of the MPEP clearly makes reference to the "process of using as claimed," not an alleged implied process resulting from using the device or composition as claimed. Nor does this section of the MPEP suggest the meaning of "related" which is relied on for the basis of the Restriction.

Contrary to the assertion in the Restriction (see April 2003 Office Action), the claims of Group I and the claims of Groups II and III are not related as products and process of use, but instead are related as subcombination and combination. See MPEP 806.05(c). This type of relationship requires a two-way distinctness for restriction and such two-way distinctiveness has not been shown. Further, there is no serious burden imposed upon the PTO in examining the claims of Group II and III with the elected claims of Group I. See MPEP §803. Once the product claims of Group I are found to be allowable, the combination claims of Groups II and III will also necessarily be allowable.

The Examiner's comments in the recent action regarding *In re Ochiai* and the comments regarding the non-elected claims not being drawn exclusively to the allowable product are not understood. Firstly, as noted above, claims 11-

14 are not drawn to processes of using or making. Secondly, these claims do recite all of the features of allowable claim 1. See MPEP §821.04.

#### Election of Species

With regards to the Examiners' request to cancel non-elected subject matter from the claims, the MPEP at Section 803.02, states the proper procedure for examination of a Markush claim, such as that herein, which recites a genus encompassing a variety of compounds. The MPEP states that, following election, the Markush-type claims will be examined fully with respect to the elected species *and further to the extent necessary to determine patentability*. The MPEP states that

"should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim *will be extended*. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a non-elected species, the Markush-type claims shall be rejected..." [Emphasis added.]

For the forgoing reasons, Applicants request that the Examiner to withdraw the Restriction Requirement set forth in the Office Action of April 21, 2003 and examine the claims of Groups II and Groups III with the elected claims of Group I.

Furthermore, with respect to the non-elected species, Applicants respectfully request the Examiner to follow the established practice for examining Markush-type claims as set forth in MPEP 803.02.

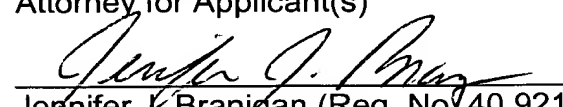
It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated

with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
\_\_\_\_\_  
Brian Heaney (Reg. No. 32,542)  
Attorney for Applicant(s)

  
\_\_\_\_\_  
Jennifer J. Branigan (Reg. No. 40,921)  
Agent for Applicant(s)

MILLEN, WHITE, ZELANO  
& BRANIGAN, P.C.  
Arlington Courthouse Plaza 1, Suite 1400  
2200 Clarendon Boulevard  
Arlington, Virginia 22201  
Telephone: (703) 243-6333  
Facsimile: (703) 243-6410  
Attorney Docket No.: Merck 2264  
Date: **7 April 2005**